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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/910,720 | 07/24/2001 | James P. Hearn | 8932-177 | 1799 |

51832 7590 01/29/2007
JONES DAY
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NEW YORK, NY 10017-6702

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| EXAMINER |
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RAMANA, ANURADHA

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| ART UNIT | PAPER NUMBER |
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3733

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
|----------------------------------------|------------|---------------|
| 3 MONTHS | 01/29/2007 | PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/910,720

Applicant(s)

HEARN ET AL.

Examiner

Anu Ramana

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-16,27,31-39,41,43-46,49,51-54,64-67,72,73,76,78-85 and 87-99 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Continuation of Disposition of Claims: Claims pending in the application are 1,2,5-16,27,31-39,41,43-46,49,51-54,64-67,72,73,76,78-85 and 87-99.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 45-46, 49, 88-90 and 93-99 are rejected under 35 U.S.C. 102(b) as being anticipated by Marchesi (US 4,736,494).

Marchesi discloses a clamp including a first clamping member 23, a smooth extension member 21 extending from the first clamping member, a second clamping member 1 comprising a plurality of radial cutouts 2 and an integrally formed stop 22 for limiting movement of the second clamping member on the extension member (Figs. 1 and 2, col. 2, lines 16-68, col. 3 and col. 4, lines 1-58).

It is noted that a claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987).

Claims 1, 2, 5-11, 15, 27-36, 39, 41, 43, 45-46, 49, 51-54, 65, 67, 78-85, 87-90 and 93-99 are rejected under 35 U.S.C. 102(e) as being anticipated by Herrington et al. (US 6,379,363).

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Herrington et al. disclose a cranial clamp having a smooth base or first clamping member 12, a head 30 disposed proximate first clamping member with a bore, a stem or "substantially smooth extension member" or "tube" 16 placed in the bore of head 30, a smooth cap or second clamping member 14 and an "integrally formed stop member" or "crimp" or "ridge" or "twisted portion" or "proximal flared portion" 32 which limits the movement of clamping member 14 on extension member 16 (Figures 1 and 21e, col. 4, lines 4-67 and col. 5, lines 5-31).

Herrington et al. also disclose second clamping member as having radial cutouts 54 extending inwardly from an outer circumference of the clamping member 14 (Fig. 3, col. 4, lines 59-64 and col. 5, lines 5-17).

Regarding claims 10, 35, 83 and 99, opening 59 includes a countersink or an "enlarged opening" (Figures 1 and 3).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 12-14, 16, 37-38, 44, 64, 72, 76, 91 and 92 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herrington et al. (US 6,379,363).

Herrington et al. disclose all elements of the claimed invention except for: (1) a fastener hole in the second clamping member; and (2) an extension member that is a ribbon or a longitudinal member with a rectangular cross section.

Regarding claims 12-14 and 76, although Herrington et al. do not disclose that extension member 16 is a ribbon or a longitudinal member with a longitudinal cross section, it would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute a ribbon for the extension member wherein so doing would amount to mere substitution of one functionally equivalent structure for another

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within the same art, namely, a structure capable of being sheared off against a suitable surface, and the selection of any of these structures would work equally well in the claimed device.

Regarding claims 16, 44, 64 and 72, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided a fastener hole in the second clamping member for securing the clamping member since it is well known in the art to utilize fasteners for the purpose of securing one member to another.

Response to Arguments

Applicant's arguments submitted under "REMARKS" in the response filed on October 12, 2006 have been carefully considered.

Upon further consideration, the Examiner is withdrawing the indicated allowability of claims and rejecting claims over Herrington et al., since the limitation "substantially smooth" or "smooth" only requires an extension member that is largely but not completely smooth. The Examiner suggests that Applicants' claim a completely smooth extension member to overcome the rejections made in this action. Further, it is suggested that Applicants claim completely smooth clamping members to avoid any rejections over Lerch.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anu Ramana whose telephone number is (571) 272-4718. The examiner can normally be reached Monday through Friday between 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached at (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AR
January 22, 2007

Anuradha Ramana